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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/000,743 12/30/97 VIDAL J 6317/2

KUHN AND MULLER  
405 LEXINGTON AVENUE  
NEW YORK NY 10174

LM02/0805

EXAMINER

HUBER, P

ART UNIT	PAPER NUMBER
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2753

DATE MAILED:

08/05/99

*4*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/000,743

Applicant(s)  
Vidal et al.

Examiner  
Huber, Paul W.

Group Art Unit  
2753



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-34 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-34 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2753

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-11 and 19-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Tseng et al. (USP-5,898,119).

Tseng et al. (Tseng) discloses a CD player for reproducing compressed digital audio data recorded on a CD-ROM 10. The audio data is compressed by MPEG Layer-3 compression (*see* Fig. 3 and Fig. 5). The CD player further includes an integrated circuit chip (processor unit 20) which is programmed to decompress the compressed data and produce a non-compressed audio output.

Art Unit: 2753

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12-18 and 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tseng et al., as applied to claims 1-11 and 19-26, in further view of Official Notice.

Tseng et al. discloses the invention as claimed, including compressing digital audio data using MPEG Layer-3 compression and recording the compressed data on the CD 10 (*See* Fig. 3), but fails to specifically teach that the digital audio data originated by first reading another prerecorded CD as claimed. However, it is manifestly well known in the art that one can duplicate or copy information by first reproducing digital audio data from a first CD then compressing and storing the digital audio data onto a second CD as claimed, (e.g., *see* Class 369,

Art Unit: 2753

Subclass 84), for the purpose of making a duplication or copy of the information stored on the first CD, and Official Notice is hereby given.

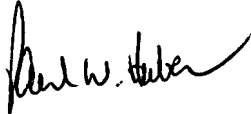
It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tseng such that the digital audio data compressed and recorded on the CD 10 originated by reproducing another prerecorded CD as claimed. A practitioner in the art would have been motivated to do this for the purpose of making a duplication or copy of the information stored on the first CD.

Relative to the doctrine of OFFICIAL NOTICE, *see In re Fox*, 176 U.S.P.Q. 340 at 341 (CCPA 1973).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Galbi discloses a method for decoding MPEG audio data.

Any inquiry concerning this communication should be directed to Paul W. Huber at telephone number (703) 308-1549.

pwh  
July 30, 1999

  
**PAUL W. HUBER**  
**PRIMARY EXAMINER**